

REMARKS

Applicants respectfully request entry of this amendment. Applicants reserve the right to prosecute subject matter withdrawn from consideration by cancellation or amendment in one or more continuation, continuation-in-part, or divisional applications.

Status of Claims

Claims 1-4, 6, and 9-13 are pending. Claims 1, 4, and 10-13 are currently amended.

Support for Amendments

The specification is amended to make the title and abstract more descriptive of the invention. Support for these amendments are found in paragraph 1 of page 3 on the specification. The specification is further amended to delete the embedded hyperlink. These amendments add no new matter. Reconsideration and withdrawal of the pending objection is respectfully requested.

Claim 1 is amended to delete the percentage of sequence identifier and to replace it with the text "wherein the non-plant 3' termination sequence is a fungal 3' termination sequence." Support for this amendment is found in paragraph 1 of page 3 on the specification. This amendment adds no new matter.

Claim 4 is amended to change the 70% sequence identity to SEQ ID NO:1 to 90%. Support for this amendment is found in paragraph 5 on page 3 of the specification. This amendment adds no new matter.

Claims 10-13 are amended to delete reference to native animal 3' termination regions, in accordance with the amendment to claim 1 noted above. Claim 13 is also amended to delete "identical to". Support for these amendments is found in the claims as originally filed. These amendments add no new matter.

Claim Rejections

Claim 4 is rejected under 35 USC §112, first paragraph as allegedly failing to comply with the written description. Upon entry of this paper, Claim 4 is amended to claim a 3' termination sequence with at least 90% sequence identity to SEQ ID NO:1.

Applicants respectfully disagree with the Examiner regarding the application of *University of California v. Eli Lilly and Co.* to the invention. 119 F.3d 1559 (Fed. Cir. 1997). In that case, the Federal Circuit stated, "A description of a genus of cDNAs may be achieved by means of recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to members of the genus, which features constitute a substantial portion of the genus." *Id.* at 1569. Here, Applicants point out that Claim 4 depends from Claim 1, which specifies conserved structural features. The Examiner is also directed to Figure 4.

Moreover, Applicants disclose and tested a large number of sequences. Specifically, the Examples in the Specification disclose tests of nine *Saccharomyces cerevisiae*, three *Aspergillus nidulans*, one *Pichia pastoris*, and four *Homo sapiens* sequences. Applicants urge that this disclosure provides adequate representative examples to support the pending claims. Reconsideration and withdrawal of the pending rejection is respectfully requested.

Claims 1 and 10-13 are rejected under 35 USC §112, second paragraph as allegedly failing to point out and distinctly claim the invention. The Examiner believes these claims are indefinite in reciting percent identity to nucleotide sequences identified only by organismal source.

Applicants traverse the rejection of Claim 1 and 10-13 as indefinite. The claim language clearly indicates that the sequence identity is between two nucleotide sequences, where one of the nucleotide sequences is functional in a particular organism. Determining nucleotide sequence termination function from organisms is an art-recognized technique. Applicants assert that one of ordinary skill in the art would understand the claims as currently pending.

Claims 1-3 and 9-13 are rejected under 35 USC §102(b) as allegedly being anticipated by Rothnie *et al.* However, Rothnie *et al.* is not relevant because it discloses the polyadenylation sequence of the cauliflower mosaic virus (CaMV). CaMV elements are

excluded from the claims by the definition of "non-plant," which Applicants define in the specification in paragraph 40, page 9:

The term "non-plant", in relation to isolated biological material, refers to a biological source incapable of undergoing photosynthesis under any circumstances. In relation to synthetic or semi-synthetic material, the term "non-plant" refers to any composition that is not identical to a composition found in plants. For example, a "non-plant 3' termination sequence" is any 3' termination sequence that is not identical in nucleotide sequence to a 3' termination sequence known to exist in any plant or plant pathogen that inserts its DNA into the plant (e.g. Agrobacterium, plant viruses). In the context of this definition, the term "plants" encompasses the organisms classified in the Kingdom Plantae while excluding members of the Kingdom Animalia and the Kingdom Fungi.

Since CaMV is a plant virus and therefore fails the limitation of "non-plant," its polyadenylation sequence is not encompassed by the claims, thus Applicants believe there is no anticipation. Reconsideration and withdrawal of the pending rejection is respectfully requested.

CONCLUSION

It is believed that the elected claims are in condition for allowance. Early and favorable action by the Examiner is earnestly requested.

AUTHORIZATION

No fee is believed due. However, the Commissioner is hereby authorized to charge any fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 2119-4281US1.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2119-4281US1. A DUPLICATE OF THIS SHEET IS ATTACHED.

Respectfully submitted,

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Dated: June 9, 2006

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